Art Unit 2901

Paper No. 27

Appeal No. 92-1511

LLB

HEARD:
May 19, 1992

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Anthony Maglica[1]

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Application for Design Patent filed September 22, 1989, Serial No. 410,965, a Division of Serial No. 356,361 filed May 23, 1989, now U.S. Patent No. 4,942,505, which is a Continuation of Serial No. 222,378 filed July 19, 1988, now U.S. Patent No. 4,899,265, which is a Continuation of Serial No. 34,918 filed April 6, 1987, now abandoned, which is a Continuation of Serial No. 828,729 filed February 11, 1986, now U.S. Patent No. 4,658,336, which is a Continuation of Serial No. 648,032 filed September 6, 1984, now U.S. Patent No. 4,577,263. Miniature Flashlight.

Robert C. Weiss et al. for appellant.

Primary Examiner - Susan J. Lucas.
Examiner - Melanie Tung.

[1] In various papers filed by appellant, including appellant's briefs, the applicant is incorrectly identified as applicant's assignee company, Mag Instrument, Inc. In this regard, 37 CFR 1.41(b) states that the word "applicant" should be used to refer to the inventor or inventors with the exceptions (none of which is applicable here) set forth in §§ 1.42, 1.43 and 1.47.

Appeal No. 92-1511

Before McCandlish, Parsons and Lyddane, Examiners-in-Chief.

McCandlish, Examiner-in-Chief.

This appeal is from the examiner's rejection of the following design claim under 35 USC 103:[2]

> The ornamental design of a flashlight as shown and described.

In rejecting the appealed claim, the examiner relies upon the following patents:

Maglica[3]	4,658,336	Apr. 14, 1987 (filed Feb. 11, 1986)
Huang	4,750,095	June 7, 1988 (filed Aug. 11, 1986)

The appealed claim stands rejected under 35 USC 103 as being unpatentable over the Maglica patent in view of the Huang patent. The examiner considers that the teachings of Huang would

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[2] A copy of the claim on appeal is found on page 3 of the examiner's answer.

[3] This is appellant's own patent which issued on appellant's second filed utility application Serial No. 828,729 which is stated to be a continuation of appellant's first filed application Serial No. 648,032 filed September 6, 1984. As far as we can see, the examiner has not stated her reasons for preferring to rely upon this patent rather than the patent (Patent No. 4,577,263) which issued on appellant's first filed application Serial No. 648,032.

have made it obvious to provide the flashlight head of Maglica with a rounded shape. Reference is made to the examiner's answer for further details of her rejection.

The only argument supporting patentability over the applied patents is that the patents do not qualify as prior art because appellant is entitled under the provisions of 35 USC 120 to the benefit of the filing date of appellant's first filed utility application Serial No. 648,032, that filing date being earlier than the effective dates of the Maglica and Huang patents. See pages 1 and 2 of appellant's main brief.

Appellant does not otherwise question the rejection of the appealed claim if the present design application is not accorded the benefit of the filing date of appellant's utility application Serial No. 648,032. Therefore, a detailed analysis of the references and the application of those references is not necessary. See In re Ahlbrecht, 435 F.2d 908, 168 USPQ 293 (CCPA 1971).

At the outset, it should be noted that there is no dispute that where the requirements of 35 USC 120 are satisfied, an application for a design patent filed as a division of an earlier filed application for a utility patent is entitled to the benefit of the earlier filing date of the utility application. See Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418, 11 USPQ2d 1300 (Fed. Cir. 1989).

In the present case, the instant application was filed as a continuation of appellant's utility application Serial No. 356,361 under 37 CFR 1.60. As a result of amendment C (Paper No. 12) filed May 29, 1991, the instant application is now stated to be a division of the earlier filed utility application Serial No. 356,361.

Utility application Serial No. 356,361, as evidenced by the caption on the first page of this decision, is the last of a long series of utility applications of overlapping copendency, commencing with appellant's first filed utility application Serial No. 648,032 filed September 6, 1984.

One requirement for obtaining the benefit of the filing date of the first filed utility application is that the invention now claimed must be disclosed in the series of preceding utility applications, including the first filed application Serial No. 648,032. See In re Lukach, 442 F.2d 967, 169 USPQ 795 (CCPA 1971).

In the present case, the subject matter now claimed is represented by the three sheets of drawings containing Figures 1 through 18 filed with amendment C (Paper No. 12) on May 29, 1991 and by the description of those drawings set forth in amendment B (Paper No. 9) filed February 13, 1991 and amended in amendment C. The content of the drawings, of course, is of special importance in a design application because, unlike the usual utility

application, the drawings in a design application represent the claimed subject matter in view of the recitation in the claim that the invention is an ornamental design as shown and described.

Thus, to leave no doubt as to the subject matter presently claimed, we have attached as Appendix I photocopies of the sheets of the three drawings presently in the application as submitted with amendment C. We have also attached as Appendix II photocopies of the pages of the description of those drawings as amended by amendment C.

The set of drawings filed with amendment C replaced a set of drawings filed with amendment B (Paper No. 9) which, in turn, replaced a set of drawings filed with a preliminary amendment (amendment A) filed on September 22, 1989. The drawings filed with the preliminary amendment A did not constitute a part of the original application as filed, but instead replaced two sheets of original drawings filed as part of the application on September 22, 1989.

We have attached photocopies of these two sheets of original drawings in Appendix III. These original drawings are photocopies of the original drawings filed in appellant's first filed utility application Serial No. 648,032. In fact, the instant design application as originally filed is a photocopy of the entire contents (drawings, specification and claims) of

appellant's utility application Serial No. 648,032 as originally filed on September 6, 1984.

According to In re Lukach, supra:

> One requirement for obtaining that benefit [of the filing date of the earlier application] is that the invention now claimed has to have been disclosed in both the parent and grandparent applications "in the manner provided by the first paragraph of section 112." (Id. at 169 USPQ at 796)

See also In re Scheiber, 587 F.2d 59, 199 USPQ 782 (CCPA 1978) and Racing Strollers Inc. v. TRI Industries Inc., supra. With regard to meeting the requirements of §112, the court in Racing Strollers stated as follows:

> As a practical matter, meeting the remaining requirements of §112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein by the prescribed formal claim. (Id. at 11 USPQ2d at 1301)

In In re Salmon, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983), the court characterized the test for compliance with §120 in a design application situation as follows:

> Insofar as here pertinent, these two provisions together require that for section 120 to apply, the first application must disclose "the invention" claimed in the

> second application. With respect to the design patent involved in this case, those provisions require that the stool design claimed in the second application must be the same design disclosed in the parent application. (Id. at 217 USPQ at 983) (Citations omitted)

Applying the foregoing principles to the present case, the series of appellant's prior utility applications commencing with the first filed application Serial No. 648,032 extending up to the last filed utility application Serial No. 356,361 must disclose the same design now claimed in the instant application.

Despite the fact that all but one figure of the utility application drawings of Serial No. 648,032 have been replaced with numerous additional figures (specifically Figures 2 through 18) and that the only remaining figure (the perspective of Figure 1 in the instant application (see Appendix I) has been modified so that it no longer corresponds identically to Figure 1 of the utility application drawings (see Appendix III which, as previously indicated, contains photocopies of the original utility application drawings), the only debate between the examiner and appellant centers on the head portion of the flashlight. In this regard, Figure 1 in the utility patent application drawings shows a parting line (referred to by appellant in the briefs as a mid-line). In comparison, the head portion shown in Figure 1 of the pending design drawings of the

instant application contains no such parting line and has a profile which is more rounded than that shown in Figure 1 of the utility application drawings. We have identified this parting line by the reference character Bd 1 in the photocopy in Appendix III.

Appellant contends in the paragraph bridging pages 8 and 9 of the main brief that the draftsman made an error in drawing the parting line Bd 1 in Figure 1 of the utility application drawings. In support of this position, appellant relies upon his declaration filed August 13, 1991. Appellant further contends that this error created "an inconsistency between Figure 1 and Figures 2 and 3 of the original [utility application] drawings" (main brief, page 9).

The examiner disputes this position, asserting that there is no inconsistency between Figures 2 and 3, on the one hand, and Figure 1, on the other hand, of the utility application drawings. In support of this position, the examiner attached photoprints A and B to her answer, copies of which are attached to this decision in Appendix IV. Photoprint A is a photocopy of the first sheet of the original drawings filed in the instant application and containing Figures 1 through 3 (see Appendix III). This sheet of drawings, as noted supra, is a photocopy of the first sheet of the original drawings from the '032 utility application (i.e., Serial No. 648,032). Photoprint B is a

photocopy of the first sheet of drawings now pending in the instant application and containing Figures 1 through 6.

In Figure 1 of Photoprint A, the examiner has drawn two straight intersecting lines which we have marked as Bd 2 and Bd 3, respectively. Line Bd 2 extends along the upper side contour line of the cylindrical portion of the head, and line Bd 3 extends along the upper side contour line of a rearward tapered portion of the head (tapered in the sense that, as shown in original Figure 2 of the '032 utility application drawings, the portion becomes gradually smaller towards one end). In the photoprint A of Appendix IV, we have marked the forward, cylindrical portion of the head as Bd 4 and the rearward and the tapered portion of the head as Bd 5.

The intersecting lines Bd 2 and Bd 3 in Figure 1 of the original drawings filed in the subject application indicate that the juncture between the cylindrical portion Bd 4 and the tapered portion Bd 5 of the flashlight head is relatively sharp or angled as the examiner describes it rather than being rounded as now shown in Figure 1 of the pending drawings (see Appendix I). To demonstrate this point, the examiner has drawn similar straight, intersecting lines along the upper profile line in Figure 1 of photoprint B. In Appendix IV, we have marked these intersecting lines as Bd 6 and Bd 7.

According to the examiner, the straight intersecting lines Bd 6 and Bd 7 show a space at the juncture between the cylindrical head portion Bd 4 and the tapered head portion Bd 5 to support her position that the juncture shown in Figure 1 of photoprint B (i.e., the currently pending Figure 1) is rounded and thus different from the angled or relatively sharp juncture shown in Figure 1 of photoprint A (i.e., the Figure as originally filed in the subject application and also as originally filed in the '032 utility application).

The examiner also contends that the profile of the head shown in Figure 1 of the drawings originally filed in the '032 utility application is not inconsistent with the profile of the head illustrated in Figures 2 and 3 of these drawings. In support of this, the examiner has drawn on photoprint A (Appendix IV) straight intersecting lines along the side profiles of the cylindrical and tapered portions of the head shown in Figures 2 and 3. We have marked the examiner's intersecting lines shown in Figures 2 and 3 of photoprint A (Appendix IV) by the same reference characters used to designate the corresponding intersecting lines shown in Figure 1 photoprint A, namely Bd 2 and Bd 3. According to the examiner, the intersecting lines Bd 2 and Bd 3 in Figures 2 and 3 of photoprint A show that the juncture between the cylindrical head portion Bd 4 and the

tapered head portion Bd 5 closely corresponds to the angled configuration shown in Figure 1 of photoprint A.

In response to the examiner's answer, appellant has submitted with his reply brief, the McAlister declaration which is accompanied by Exhibits III through XV. A copy of this McAlister declaration is attached to our decision as Appendix V. Copies of the McAlister declaration exhibits IV, V, VII, VIII and X through XV are attached to this decision as Appendix VI.

By greatly enlarging Figures 2 and 3 of the examiner's photoprint A by approximately five times (see particularly the McAlister declaration Exhibits VII and VIII) the declarant has endeavored to establish that in order to show an angled juncture between the cylindrical and tapered head portions (Bd 4, Bd 5) the examiner improperly skewed the intersecting lines (Bd 2, Bd 3) and drew at least one line (Bd 3) along the inside edge of the contour line in Figure 2 of photoprint A. According to appellant, the McAlister declaration also establishes that when the intersecting lines are properly drawn on the greatly enlarged reproductions of the longitudinal cross sections shown in Figures 2 and 3 of photoprint A, the juncture between the cylindrical and tapered head portions (Bd 4, Bd 5) is rounded, not angled and thus is inconsistent with the shape of the head shown in Figure 1 of photoprint A.

The McAlister declaration goes on to state in paragraph 9 as follows:

> A comparison of Figure 2 of the original patent drawings, Exhibit VI, with the final assembly drawing, Exhibit V, shows that, with the exception of certain internal components of the bulb holder assembly, Figure 2 of the original patent drawings was copied from the final assembly drawing and therefore includes a flashlight head with the original 4.80 inch radius curved contour or profile.

According to the McAlister declaration, the profile of the flashlight head shown in the final assembly engineering drawing (McAlister declaration Exhibit V) was copied from the engineering parts drawing (McAlister declaration Exhibit IV). As stated in paragraph 9 of the McAlister declaration, the side contour of the flashlight head shown in the parts drawing (Exhibit IV) was drawn with an original 4.80 inch radius. Based on these assertions, appellant argues that the shape of the head shown in Figure 1 of the original '032 utility application drawings contains a draftsman's error (see page 4 of the reply brief).

As we understand appellant's position, particularly as outlined in the reply brief and also in the McAlister declaration (see Appendix V), the parting line Bd 1 in Figure 1 of Appendix III may be deleted and the side contour of the flashlight head may be made more rounded without introducing what is normally

termed as "new matter" because these differences amount to minor drawing errors and inconsistencies which cannot be used to support a rejection under §112 (see page 8 of the reply brief). In support of this position, appellant cites Ex parte Asano, 201 USPQ 315 (Bd. App. 1978).

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments and evidence. As a result, we conclude that, particularly as argued, the rejection of the appealed claim is sustainable not only for the reasons advanced by the examiner but also for additional reasons stated infra in our analysis.

Since the merits of the §103 rejection itself have not been argued apart from the contention that the applied patents do not qualify as prior art, the dispositive issue in this case is whether the appellant's first filed utility application Serial No. 648,032 contains illustrations, as supported by the description therein, depicting the ornamental design claimed in the instant application. See Racing Strollers Inc. v. TRI Industries Inc., supra.

Stated somewhat differently, the dispositive issue in this case with regard to the examiner's §103 rejection is whether the disclosure in the first filed utility application Serial No. 648,032 supports the claimed invention in the instant application as shown (see Appendix I) and described (see Appendix II). If it

does, then appellant is entitled to the benefit of the filing date of the first filed utility application, and the applied patents consequently do not qualify as prior art under §102. On the other hand, if the original disclosure in the first filed utility patent application does not support the claimed subject matter of the instant application as shown in the currently pending set of design drawings (see Appendix I) and described in the specification as currently amended (see Appendix II), then appellant is not entitled to the benefit of the filing date of any of the utility patent applications filed before the instant design application, and the applied patents do qualify as prior art to provide a basis for a rejection under §103.

Based upon the evidence and appellant's arguments as outlined supra, appellant seems to suggest that since the engineering assembly drawing (McAlister declaration Exhibit V in our Appendix VI) was copied from the engineering parts drawing (see the McAlister declaration Exhibit IV in our Appendix VI) and since Figure 2 of the first filed utility patent application was "copied" (paragraph 9 of the McAlister declaration filed November 25, 1991) from the engineering assembly drawing (McAlister declaration Exhibit V), it follows that the profile of the longitudinal cross section shown in Figure 2 of the original utility patent application not only has a smoothly curved juncture between the cylindrical and tapered head portions Bd 4

and Bd 5, but also "includes a flashlight head with the original 4.80 inch radius curved contour or profile" (paragraph 9 of the McAlister declaration filed November 25, 1991) (see our Appendix V). We have three major points to make about this position.

First, while the McAlister declaration states that the draftsman had the engineering assembly drawing (McAlister declaration Exhibit V), it does not state that the draftsman also had the engineering parts drawing (McAlister declaration Exhibit IV).

Second, as will be discussed in detail infra, the longitudinal cross sections shown in Figures 2 and 3 of the original drawings filed in the '032 utility patent application before they were inked in the final form appearing in the issued patent, are not faithful reproductions of the flashlight head profile shown in either the McAlister declaration Exhibit V or the McAlister declaration Exhibit IV.

Third, the flashlight head profile shown in the engineering assembly drawing (McAlister declaration Exhibit V) is, by itself, ambiguous in that it is not clear that the juncture between the cylindrical and tapered head portions Bd 4 and Bd 5 have the original 4.80 inch radius or is otherwise smoothly curved.

Considering the second point, we have conducted an examination of the drawings in question which we shall refer to

as an "overlay/window" examination in which the photocopy of one drawing is taped to an outside window and the photocopy of a second drawing drawn to the same scale is placed over the taped copy so that both may be seen superimposed one upon the other.

When the engineering assembly drawing (McAlister declaration Exhibit V) is taped to the outside window and Figure 2 of the original photocopy of the drawings originally filed in the '032 utility application is placed over and aligned with the longitudinal cross section shown in the engineering assembly drawing, a significant, albeit small, difference is seen between the side profile or contour lines of the heads in the two figures. In particular, the juncture between the cylindrical and tapered head portions Bd 4 and Bd 5 in Figure 2 of the '032 utility application drawing is somewhat sharper than the juncture between the cylindrical and tapered head portions in the engineering assembly drawing. A corresponding difference is seen when Figure 2 in the photocopy of the original drawing of the '032 utility application drawing is placed over the engineering parts drawing (McAlister declaration Exhibit IV).

Likewise, a similar difference is seen when Figure 3 in the original photocopy of the drawing as originally filed in the '032 utility patent application is placed over a taped copy of the engineering assembly drawing (McAlister declaration Exhibit V) and also over a taped copy of the engineering parts drawing

(McAlister declaration Exhibit IV). In lining up Figures 2 and 3 of the photocopy of the drawings originally filed in the '032 utility application with the taped copy of the engineering parts drawing (McAlister declaration Exhibit IV), the rear edges of the flashlight heads were aligned to make the comparison.

Although the juncture between the cylindrical and tapered head portions Bd 4 and Bd 5 in Figures 2 and 3 of the original photocopy (Appendix III) does not define a pointed corner, the juncture is nevertheless sharp enough when viewed from the normal size of the drawing to conclude that it was not inconsistent or a draftsman's error to add the parting line Bd 1 to the perspective view in Figure 1 of the drawings originally filed in the '032 utility application.

With regard to our third point, the ambiguity in the engineering assembly drawing (McAlister declaration Exhibit V) arises from the breaks that were made in the upper and lower side profile lines of the flashlight head to provide for the passage of the lead lines from the reference numerals 8 and 9 on the drawing. We have marked these breaks or gaps by the reference character Bd 8 in the copy of the McAlister declaration Exhibit V in our Appendix VI. These breaks occur in the region of the juncture between the cylindrical and tapered head portions Bd 4 and Bd 5 to thus obscure the precise shape of the juncture. In fact, the breaks even convey the impression that the juncture is

not as smoothly curved as indicated in the engineering parts drawing (McAlister declaration Exhibit IV).

Although the McAlister declaration (filed November 25, 1991) states in paragraph 4 that "original engineering drawings" were "used" by the patent draftsman to prepare the patent drawings, only one engineering drawing was stated to be "copied" (paragraph 9 of the McAlister declaration filed November 25, 1991). Thus, as far as the evidence before us is concerned, there is no indication that the patent draftsman was given a copy of the engineering parts drawing (McAlister declaration Exhibit IV) or that the profile of the flashlight head shown in Figures 2 and 3 of the drawings originally filed in the '032 utility patent application was copied from any engineering drawing other than the engineering assembly drawing (McAlister declaration Exhibit V). Thus, the gaps or breaks Bd 8 in the upper and lower contour lines of the head in the engineering assembly drawing (McAlister declaration Exhibit V) may very well account for the somewhat sharper juncture between the cylindrical and tapered head portions Bd 4 and Bd 5 in Figures 2 and 3 of the drawings as originally filed in the '032 utility application.

Furthermore, with regard to the allegation that "the original patent drawings was [sic, were] copied from the final assembly drawing [McAlister declaration Exhibit V]" (paragraph 9 of the McAlister declaration filed November 25, 1991), no facts

are set forth in the McAlister declaration to establish that the declarant had first hand knowledge of such copying. Customarily, the attorney or practitioner preparing the application selects and furnishes copies of drawings to the draftsman for making the patent application drawings. In the present case, appellant has chosen not to furnish us with a declaration or sworn statement by either the draftsman who prepared the original utility patent application drawings or the practitioner who prepared the application. If the McAlister statement quoted supra is merely hearsay, it is entitled to little weight. See In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973).

In the final analysis, even if the draftsman did make a mistake in copying whatever drawings may have been supplied to him, that in itself does not excuse appellant from compliance with the statute, specifically the requirements in the first paragraph of 35 USC 112. Certainly, appellant has cited no authority to support such a proposition.

Furthermore, the greatly magnified enlargements of Figures 2 and 3 accompanying the aforementioned McAlister declaration are unavailing. In the first place, it is evident that the examiner herself did not have the benefit of such enlargements to ensure that the straight, intersecting lines Bd 2 and Bd 3 drawn on photoprint A (our Appendix IV) were not even slightly skewed and were precisely drawn along the outside edges

of the contour lines. The question here is not whether there are slight imperfections that appear only when the Figures 2 and 3 are greatly magnified. Instead, the question is how the profile of the flashlight head is viewed from the normal size of the drawings at the scale shown in the drawings as originally filed in the '032 utility application (see the photocopies in our Appendix III).

As a matter of fact, the enlargement (five times magnified), of photoprint A of Figure 2 in the McAlister declaration Exhibit VII shows that even for this substantial magnification, the examiner's straight line Bd 3 is off by what amounts to no more than the thickness of a thin pencil line. Even for this great magnification of Figure 2, we do not perceive that there would be any significant difference if line Bd 3 were drawn precisely on the outside edge of the side contour line on the normal size of the drawing.

We also have other difficulties with the enlargements of Figures 2 and 3 of the utility application (which corresponds to Figures 2 and 3 as originally filed in the instant application). In the first place, the lines of the illustration of Figure 2 in the McAlister declaration Exhibit VII are significantly darker, heavier and thicker than the lines in the McAlister declaration Exhibit XI. Furthermore, when subjected to the overlay/window examination, it is clear that the two

enlargements in the McAlister declaration Exhibits VII and XI do not match, one apparently being a distortion with respect to the other.

The difference in line thickness between the McAlister declaration Exhibits VII and XI by themselves would constitute a source of ambiguity in an effort to determine the true shape of the juncture between the cylindrical and tapered head portions Bd 4 and Bd 5. The same criticisms apply to a comparison of the enlargements of Figure 3 in the McAlister declaration Exhibits VIII and XII.

The enlargements of the Figures 2 and 3 of the finally inked drawings (McAlister declaration Exhibits XIII and XIV) introduce further inaccuracies in that the thicknesses of some of the inked lines defining the contour of the flashlight head are at a distinct variance with the thickness of the lines in the drawings as originally filed. Compare, for example, the thickness of the lower contour line of the flashlight head in the McAlister declaration Exhibit XIII with the corresponding contour line in the McAlister declaration Exhibit XII. This variation in thickness is also apparent from a comparison of the normal size drawings. Furthermore, when subjected to an overlay/window examination, the enlargement of Figure 2 in the McAlister declaration Exhibit XIII appears to be distorted with respect to the McAlister declaration Exhibit XI. Similar criticisms apply

to the enlargement of Figure 3 shown in the McAlister declaration Exhibit XIV.

In view of the foregoing, we conclude that neither the first filed utility application Serial No. 648,032 nor any of the other subsequently filed utility applications in the chain of utility applications support the elimination of the parting line Bd 1 in the flashlight head and the modification of the contour of the head as shown in the presently pending design application drawings. These differences are not the type of minor draftsman's errors that would be correctable under Ex parte Asano, supra, without adding new matter. Furthermore, Asano is not applicable to new matter issues (i.e., issues pertaining to the description requirement in the first paragraph of §112) because the rejection there dealt with the enablement requirement in that paragraph and with the second paragraph of §112.

In addition to the foregoing, there are three additional design features shown or described in the presently pending design application drawings (see our Appendices I and II) which are not disclosed in either the first filed utility patent application Serial No. 648,032 or any of the other utility patent applications in the copendency chain. The first feature deals with the rear elevation view of the flashlight as shown in Figure 6. The second design feature relates to the textured pattern of the central barrel portion of the flashlight, this textured

pattern being described as knurling in the current description of drawings. The third feature relates to the band around the flashlight head which is described in the current description of Figure 13 of the drawings as also being knurling.

A separate photocopy of the sheet containing Figure 6 of the instant design application is provided in our Appendix VII. To this illustration of Figure 6 in Appendix VII, we have added certain reference characters to identify various lines and surfaces as will be discussed infra.

In Figure 6 of the instant design application, a tab corresponding to the tab 29 in Figures 1 and 2 of the '032 utility application is shown to project rearwardly along a carved out region of the tail cap 22 of the flashlight. We have added these reference numerals to the showing of Figures 1 through 4 and 6 in our Appendix VII.

In Figure 6, tab 29 is shown to terminate at a lower edge of the carved out tail cap region. We have marked this edge as Bd 9 in Appendix VII. The back face of the tail cap below the edge Bd 9 is shown in the instant design application drawings to be planar as evidenced from Figures 2 through 4 as well as Figure 6 of the instant design application. We have marked this back face of the tail cap by the reference character Bd 10.

The only showing of this portion of the rear face of the tail cap in the drawings as originally filed in the '032

utility application, however, is in Figure 2 which is a longitudinal section taken along Figure 1 of the utility application drawings. There is nothing, however, in Figure 2 or Figure 1 of the original utility application drawings to show that the back face Bd 10 is planar throughout the entire region bounded by edge Bd 9 and the cylindrical parameter Bd 11 of the tail cap. So far as the original utility application drawings are concerned, the shape of the back face Bd 10 of the tail cap is not disclosed and therefore may have cavities or similar formations which we have shaded and marked by the reference character Bd 12 in the photocopy of Figure 6 in Appendix VII.

In view of the foregoing, the disclosure in the '032 utility application does not support a showing of the back face Bd 10 of the tail cap as being planar since it may well have other shapes, such as shapes with the cavities Bd 12 as discussed supra.

Furthermore, there is no disclosure in the '032 utility application to support the showing of the tail cap in Figure 3 of the instant design application. In particular, there is no support in the disclosure of the '032 utility application for the shapes of the surfaces which we have marked as Bd 13 and Bd 14 in Figure 3 of our Appendix VII. The reference character Bd 13 represents the right hand side face of the rearwardly extending tab 29, and the reference character Bd 14 represents the tail cap

surface portion extending to the right of tab 29 above the edge Bd 9.

As evidenced from Figure 3 of the instant design application drawings, the shape of the tail cap is shown to be symmetrical about a plane containing the longitudinal axis of the flashlight and medially intersecting the tab 29. The disclosure in the original '032 utility application does not support such a showing.

This brings us to the textured pattern of the barrel portion as shown in Figures 1 through 4 of the instant design application. We have marked this pattern by the reference character Bd 15 in Figures 1 through 4 in our Appendix VII. This pattern is expressly described as knurling. See, for example, the description of Figure 7 in the amended description of drawings (our Appendix II).

There is no disclosure in the '032 utility application as originally filed that the pattern on the barrel 21 is knurled. Instead, the specification in the '032 utility application describes the surface 27 of barrel 21 as merely being a "machined hand surface". Thus, the barrel surface 27 is not necessarily a knurled surface inasmuch as there are machined surfaces other than knurled surfaces.

As far as the drawings are concerned in the original '032 application, only Figures 1 and 2 are of any relevancy.

Both of these figures, however, illustrate a mesh or net-like pattern which is much more coarsely textured as compared with the fine knurled pattern shown in the presently pending drawings of the instant design application. As compared with the interstices in the mesh pattern shown in Figures 1 and 8 of the original utility application drawings, the interstices defined by the knurled pattern in the instant design application drawings are much smaller thus providing a distinctly different appearance as compared with the pattern shown in Figure 1 and 8 of the original utility application drawings.

There also is no support in any of the utility applications as filed for the description in the instant design application that the pattern in the band on the flashlight head is knurling. We have marked this band by the reference character Bd 16 in our Appendix VII.

The specifications in the utility applications say nothing about band Bd 16. Thus, for all we know, pattern on band (see Figure 8 of the '032 utility application drawings - our Appendix III) could be nothing more than parallel lines on a cylindrical surface between two circumferential lines.

Because appellant's '032 utility application fails to disclose the foregoing design features concerning the flashlight head, the end face of the flashlight tail cap and the pattern on the flashlight barrel, the instant design application drawings

fail to comply with the description requirement in the first paragraph of §112. As a result, appellant's instant design application is not entitled under 35 USC 120 to the benefit of the filing date of his prior '032 utility application or to the filing date of any of the other utility applications in the chain of utility applications.

We will therefore affirm the examiner's §103 rejection based on the Maglica and Huang patents because, on the record before us, these references do qualify as prior art under §102. However, because our reasons supporting the rejection go beyond the examiner's position, we hereby designate our affirmance of the examiner's decision as a new ground of rejection under 37 CFR 1.196(b).

In affirming the examiner's rejection, we are not unmindful of counsel's remarks about commercial success on page 4 of the main brief. However, there is no competent evidence before us in the form of declarations or affidavits to support these contentions.

We herewith enter the following additional grounds of rejection under 37 CFR 1.196(b):

(I) Appellant's pending design claim is rejected under the first paragraph of 35 USC 112 as being based upon a disclosure which, as originally filed in the instant application, does not satisfy the description requirement in that paragraph.

In other words, the disclosure as originally filed in the instant application lacks support for the presently claimed design.

(II) Appellant's current design claim is also rejected under the second paragraph of 35 USC 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention.

Considering the new rejection under the first paragraph of §112, the disclosure as originally filed in the instant application does not support the claimed design as currently shown and described (see our Appendices I and II) for the same reason that the originally filed '032 utility application does not support the currently claimed design. The reason for this is that the specification and drawings as originally filed in the instant application are merely photocopies of the specification and drawings as originally filed in the '032 utility patent application.

Therefore, the disclosure as originally filed in the instant application lacks support for (1) the shape of the flashlight head as shown in Figure 1 and the deletion of the parting line Bd 1, (2) the description that band Bd 16 on the head is knurled, (3) the shape of the end cap surfaces Bd 10, Bd 13 and Bd 14 in Figures 3 and 6 and (4) the knurled pattern Bd 15 of the barrel portion of the flashlight as shown in Figures 1 through 4 of the application. See Ex parte Hanbeck, 231 USPQ 739

(BPAI 1986) (In a design application, an amendment to the drawings is an amendment to the claim).

As for the new rejection under the second paragraph of §112, appellant's description of the drawings (see Appendix II) states that for the flashlight shown in Figures 7 through 12, the tail cap, the knurling on the barrel and the knurling on the head form no part of the claimed design. The description of the drawings also states that for the flashlight shown in Figures 13 through 18, the knurling on the barrel and the knurling on the head form no part of the claimed design. In contrast, the tail cap, the knurling on the barrel and the knurling on the head do form a part of the claimed design for the flashlight shown in Figures 1 through 6 of the application.

In view of the foregoing, the single design claim in the application takes on distinctly different scopes when read on the flashlight of Figures 1 through 6, the flashlight of Figures 7 through 12 and the flashlight of Figures 13 through 18. Accordingly, the scope of the single design claim is indeterminate and hence indefinite because it is not seen how the single claim can be variable in scope as required by the description of drawings so that in one instance the claim includes all of the illustrated parts of the flashlight without exception, in another instance the claim covers all of the parts except for the end cap, the knurling on the barrel and the

knurling on the head, and in yet another instance the claim covers all parts except for the knurling on the barrel and the knurling on the head. For these reasons, the single design claim does not comply with the second paragraph of §112.

In reaching our conclusion concerning the indefiniteness of the design claim, we are not unmindful of the holding in In re Rubinfield, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). In this case, the court stated that in a proper case, different illustrated embodiments may be covered by a single design claim provided that those embodiments involve a single inventive concept.

In re Rubinfield, supra is not applicable here because appellant's currently pending drawings (see Appendix I) do not illustrate different embodiments. Instead, the flashlight designs shown in (1) Figures 1 through 6, (2) Figures 7 through 12 and (3) Figures 13 through 18 are all one and the same. The only difference resides in what appellant has attempted to claim with regard to the flashlight design. In particular, through the use of broken lines and description of the drawings, appellant has attempted to claim two different subcombinations of the design illustrated in Figures 1 through 6 as discussed supra.

Furthermore, the Rubinfield court's approval about the use of a single design claim to cover plural embodiments, if those embodiments involve a single inventive concept, is dicta

because the issue as determined by the examiner's rejection was whether more than one claim is permissible in a design application. The Rubinfield court concluded that it was not and on that ground alone affirmed the board's decision.

Even if the single inventive concept rationale of Rubinfield is somehow applied to the subject application, the rejection under the second paragraph of §112 is not avoided. A single inventive concept is not something that appellant may arbitrarily select for coverage by a single design claim. Instead, it is implicit in Rubinfield that the single inventive concept of truly plural embodiments is determined by the facts of each particular case.

In the present case, even if it is assumed arguendo that there may be different embodiments for appellant's flashlight design, the single inventive concept required to tie the different embodiments together for coverage by a single claim would, in our view, include the head, the knurled barrel and the end cap because these are the major design features of the design as illustrated in the current drawings.

Suffice it to say that a design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design. In re Blum, 374 F.2d 904, 153 USPQ 177 (CCPA 1967).

In addition to the foregoing, the pending design claim is also indefinite because of the use of broken lines to show various features in Figures 7 through 18 including the knurling on the flashlight head, the knurling on the flashlight barrel and the end cap. We are not unmindful of the court's holding in In re Blum, supra, regarding the use of dotted or broken lines. However, the design features shown in broken lines in Figures 7 through 18 clearly constitute part of the unitary design as shown in Figures 1 through 6 of the current drawings. Appellant's attempt to exclude these features is impermissible because these features are material and therefore may not be excluded from the claimed design under In re Blum, supra.

Furthermore, the practice of making a statement in the description of the drawings that certain features of the design constitute no part of the design as claimed is in itself objectionable and not permitted. See Ex parte Remington, 1905 CD 28 (Comm'r. 1904).

In summary, the examiner's decision rejecting the appealed design claim is affirmed, but our affirmance is designated as a new ground of rejection under 37 CFR 1.196(b) for the reasons stated supra. Additionally, we have added two new grounds of rejection under the 37 CFR 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based

upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 USC 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED

Harrison E. McCandlish
Examiner-in-Chief

Marion Parsons, Jr.
Examiner-in-Chief

William E. Lyddane
Examiner-in-Chief

BOARD OF PATENT APPEALS AND INTERFERENCES

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Index of Appendices

Appendix I	-	Photocopies of the three sheets of drawings containing Figures 1 through 18 currently pending in the subject application.
Appendix II	-	A copy of the description of the current drawings (Appendix I) as amended by Amendment C.
Appendix III	-	Photocopies of the two sheets of drawings as originally filed in the instant application.
Appendix IV	-	Photocopies of the examiner's photoprints A and B.
Appendix V	-	A copy of the McAlister declaration filed November 25, 1991.
Appendix VI	-	Copies of Exhibits IV, V, VII, VIII and X through XV which accompanied the McAlister declaration (Appendix V).
Appendix VII	-	Separate photocopy of the sheet of current design drawings containing Figure 6.